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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,317	06/08/2001	John J. Sie	19281-001610	9420

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EXAMINER	
BOUTAH, ALINA A	

ART UNIT	PAPER NUMBER
2143	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/877,317	SIE ET AL.	
	Examiner	Art Unit	
	Alina N. Boutah	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 May 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15 and 19-21* is/are pending in the application.

4a) Of the above claim(s) *1-8* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-15 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to Applicant's amendment filed May 24, 2007. Claims 1-8 are withdrawn from consideration. Claims 16-18 have been cancelled. Claims 9-15 and 19-21 are pending in the present application.

Election/Restrictions

Applicant's election with traverse of claims 9-15 and 19-21 in the reply filed on May 24, 2005 is acknowledged. The traversal is on the ground(s) that claims 1, 9 and 19 would not present a serious burden if examined together. This is not found persuasive because although the classification is the same, the subject matter is different. In the instant case, within invention A (claims 1-8), the method comprises the steps of recording at least second segment of each of a second plurality of programs sent from the content provider if the user request is NOT detected before a stagger period expires; and recording the one of the first plurality of programs if the user request is detected before the stagger period expires. On the contrary, within invention B (claims 9-15 and 19-21), the method comprises the steps of: recording a second segment of the program if the user request is detected before the period expires; and discontinuing the recording of the first segment if the user request is not detected before a period expires.

Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP section 808.02), restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-15 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,729,280 issued to Inoue et al.

Regarding claim 9, Inoue teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording any first segment of each of the plurality of programs that are not already stored (col. 8, lines 35-62: recording remaining segments of program);

detecting the user request for one of the plurality of programs (col. 8, lines 35-62: user directing programs to be pre-recorded); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 8, lines 35-62: recording pre-storage of the video program as directed by user).

Although Inoue does not explicitly teach determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored, it would have been obvious to one of ordinary skill

in the art to determine if any of a first segment of a program is not already stored and recording a segment that is not already stored because doing so will allow only segments that are needed to be recorded, thus saving storage space.

Regarding claim 10, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 8, lines 35-62).

Regarding claim 11, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels (figure 2).

Regarding claim 12, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figure 1).

Regarding claim 13, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (abstract).

Regarding claim 14, although Inoue does not explicitly teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program, he teaches receiving request from user's controlling device, which in this case could be wired or wireless (col. 2, line 58 to col. 3, line 13).

Regarding claim 15, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (figure 1).

Regarding claim 19, Inoue teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of the program sent from the content provider before any user request for the program (col. 8, lines 35-62: pre-stored program; figure 2: i.e. program recorded on channel 1);

detecting the user request for the program (col. 6, lines 14-24: user that program be received); and

recording a second segment of the program if the user request is detected before the period expires (col. 8, lines 35-62: recording the rest of the program).

Although Inoue does not explicitly teach discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program, it would have been obvious to one of ordinary skill in the art to only continue recording the first segment if user request is detected in order to allow the recorder to record only needed program segments, thus saving storage space.

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

In response to Applicant's argument in claim 9 that Inoue fails to teach "determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored," as argued above, this feature would have been obvious to one of ordinary skill in the art. Specifically, it would make sense to detect a program that is stored and record only the program that is not already stored in order to allow only segment of programs that are needed to be recorded, thus saving storage space.

Regarding claim 19, Applicant argues that Inoue fails to teach "discontinuing the recording of the first segment if the user request is not detected before the period expires." The PTO respectfully submits that although this feature is not explicitly taught, it is obvious to one of ordinary skill in the art because there is no point recording a program segment that is not requested or needed, thus saving storage space.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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